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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,598	12/04/2001	Nelson R. Holcomb	10010730-2	2467

7590 12/22/2003

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EXAMINER

LIPMAN, BERNARD

ART UNIT PAPER NUMBER

1713

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

ab6

Office Action Summary	Application No.		Applicant(s)	
	10/008,598		HOLCOMB ET AL.	
	Examiner		Art Unit	
	Bernard Lipman		1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 14,15 and 18-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13,16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election with traverse of Group I, claims 1-13, 16 and 17 in Paper No. 5, filed October 21, 2003 is acknowledged. The traversal is on the ground(s) that there is no serious burden on the Examiner to combine the three groups of claims as restricted since the searches are essentially the same. This is not found persuasive because the Examiner must be the judge of burden and insofar as the searches are not co-extensive and characteristics seen from the references are not necessarily present in the different groups of claims, then consideration of references as well as searches represents a serious burden on the Examiner and the restriction remains proper.

The requirement is still deemed proper and is therefore made FINAL.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth

in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 16 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Alder et al., U.S. Patent 5,922,612 or Cole et al., U.S. Patent 5,040,047.

Both references to Alder et al. and Cole et al. teach specifically structures with polymer layers, said polymer layers containing fluorescent material as required by applicant's claims. Although the references do not specifically refer to "a calibration device", the structure of the entities of the references is identical to the structure as defined in applicant's claims except for the mention of "minimal local and global non-uniformities" in the device of the claims. The structures of the references, however, are applied in the same manner as those required by applicant's claims insofar as they are spin coated onto other layers and would be presumed to have the same uniformities absent evidence to the contrary, In re Fitzgerald et al., 205 USPQ 594. The reference to Alder et al. specifically teaches and exemplifies the same thickness of the polymer layer as required by applicant in his examples. The reference to Cole et al. specifically teaches the spin coating in

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his Example 1 of the fluorescent dye containing polymer. It is, therefore, reasonable to presume that the characteristics of the coating would be identical to those of applicant's claims absent evidence to the contrary. Under In re Fitzgerald practice it is incumbent upon the Examiner to present a reasonable presumption of the possession of the components of the prior art of characteristics required in the claims. This the Examiner has done with regard to the non-uniformities of the coatings of the references. It is now incumbent upon applicant to provide evidence that the references do not in fact possess the characteristics of the claims in order to overcome this presumption.



Bernard Lipman
Primary Examiner
Art Unit 1713

BL:cdc
December 11, 2003